

REMARKS

Claims 1-20 are pending in the application; the status of the claims is as follows:

Claims 10, 11, 13, and 15-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,946,028 to Ishikawa ("Ishikawa").

Claims 1, 2, 8, and 18-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,421,506 to Maruyama ("Maruyama").

Claims 3-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruyama, US 6,421,506 in view of Ishikawa.

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruyama in view of U.S. Patent No. 6,128,144 to Togino ("Togino").

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruyama in view of U.S. Patent No. 4,553,170 to Aoki et al ("Aoki '170").

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa in view of U.S. Patent No. 6,327,085 to Osawa et al ("Osawa").

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa in view of U.S. Patent No. 5,920,347 to Aoki ("Aoki '347").

The objection to the title of the invention as not being descriptive is noted and a new title is presented in this Amendment which is clearly indicative of the invention to which the claims are directed. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

Claim 10 has been amended to more clearly specify the claimed invention. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

35 U.S.C. § 102(b) Rejections

The rejection of claims 10, 11, 13, and 15-17 under 35 U.S.C. § 102(b) as being anticipated by Ishikawa is respectfully traversed based on the following.

Ishikawa discloses a camera having a taking lens 2 and a mirror 4 inclined at an angle to an optical axis of the taking lens. When mirror 4 is a quick return mirror as stated in the Office Action (p. 3, lines 3-6), the mirror can have a first position for a monitoring mode where no image recording occurs and a second position for photographing where the image is recorded on image forming surface 3 (col. 3, lines 16-22). When the mirror is in the first position, the image is reflected off of mirror 4 through condenser lens 7, off mirror 6, through re-forming lens 5, which focuses the reflected image on image pick-up surface 8. (Figure 1) Even if the quick return mirror is a half mirror, the image is not formed on image forming surface 3 when in the first position. Ishikawa specifically states:

In the case of a half mirror or a quick return mirror being used, a focal plane shutter is provided in front of the image forming surface 3.
(column 3, lines 7-9)

When the mirror is in a second position, it is removed from the optical path and the image is formed directly on image forming surface 3.

In contrast to the cited reference, claim 10 includes:

an optical element movable between an advanced position intersecting at an inclination the optical path from the taking lens to said image sensor, and a retracted position removed from the optical path, wherein said digital camera is controllable under a first photographic mode wherein said optical element is set at the advanced position for photography, said image sensor receiving said image through

the semitransparent mirror in said advanced position, and a second photographic mode wherein said optical element is set at the retracted position for photography, said image sensor receiving said image from said taking lens in the retracted position, and the optical path lengths from the taking lens to said image sensor are equalized in the first photographic mode and the second photographic mode by moving the taking lens in a direction along the optical axis of the taking lens.

The Office Action states that mirror 4 corresponds to the optical element of claim 10; the image pick-up surface 8 corresponds to the image sensor of claim 10; and that condenser lens 7 corresponds to the taking lens of claim 10. However, both condenser lens 7 and image pick-up surface 8 of Ishikawa receive the image from mirror 4. Mirror 4 is not “intersecting ... the optical path from the taking lens to said image sensor” as stated in claim 10. (Of importance: Figures 1 and 2 of Ishikawa show the same embodiment, but mirrors 4 and 6 are not shown in Figure 2 for explanatory purposes. (column 4, lines 4-11)) Therefore, if image pick-up surface 8 corresponds to the “image sensor” of claim 10, mirror 4 does not meet the limitation of the optical element of claim 10.

If image surface 3 is said to correspond to the “image sensor” and first image forming lens 2 is said to correspond to the “taking lens,” Ishikawa does not show or suggest that “the optical path lengths from the taking lens to said image sensor are equalized in the first photographic mode and the second photographic mode by moving the taking lens in a direction along the optical axis of the taking lens.” In summary, no characterization of Ishikawa meets the limitations of claim 10.

To anticipate, a reference must show, expressly or inherently, every limitation of the claim. MPEP §2131. Therefore, claim 10 is not anticipated by Ishikawa. Claims 11, 13, and 15-17 depend from claim 10 and thus include every limitation of claim 10. Therefore, claims 11, 13, and 15-17 are also not anticipated by the cited references

Accordingly, it is respectfully requested that the rejection of claims 10, 11, 13, and 15-17 under 35 U.S.C. § 102(b) as being anticipated by Ishikawa be reconsidered and withdrawn.

The rejection of claims 1, 2, 8, and 18-20 under 35 U.S.C. § 102(b) as being anticipated by Maruyama is respectfully traversed based on the following.

A certified translation of Japanese Patent Application No. 11-276621, from which this application claims priority under 35 U.S.C. § 119, is provided herewith. Therefore, this application is entitled to a priority date of September 29, 1999 under 35 U.S.C. § 119 and 37 C.F.R. § 1.55(a)(4) based on the filing date of the Japanese application. Muruyama has a critical date of June 2, 2000 under 35 U.S.C. § 102(e). Therefore, Muruyama is not prior to this application.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, 8, and 18-20 under 35 U.S.C. § 102(b) as being anticipated by Maruyama be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejections

The rejection of claims 3-6 under 35 U.S.C. § 103(a), as being unpatentable over Maruyama in view of Ishikawa is respectfully traversed based on the following.

As noted above, Muruyama is not prior to this application. Accordingly, it is respectfully requested that the rejection of claims 3-6 under 35 U.S.C. § 103(a) as being unpatentable over Maruyama in view of Ishikawa be reconsidered and withdrawn.

The rejection of claim 7 under 35 U.S.C. § 103(a), as being unpatentable over Maruyama in view of Togino is respectfully traversed based on the following.

As noted above, Muruyama is not prior to this application. Accordingly, it is respectfully requested that the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Maruyama in view of Togino be reconsidered and withdrawn.

The rejection of claim 9 under 35 U.S.C. § 103(a), as being unpatentable over Maruyama in view of Aoki '170, is respectfully traversed based on the following.

As noted above, Muruyama is not prior to this application. Accordingly, it is respectfully requested that the rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Maruyama in view of Aoki '170, be reconsidered and withdrawn.

The rejection of claim 12 under 35 U.S.C. § 103(a), as being unpatentable over Ishikawa in view of Osawa is respectfully traversed based on the following.

As noted above, Ishikawa does not show or suggest elements meeting the limitations of the image sensor, taking lens or optical element of claim 10. Similarly, Osawa does not show or suggest elements meeting these limitations. To support a prima facie case for obviousness, the references must show or suggest every element of the claim. MPEP §2143.03. Claim 12 is dependent upon claim 10 and thus includes every limitation of claim 10. Therefore, claim 12 is not obvious over the cited references.

Accordingly, it is respectfully requested that the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa in view of Osawa be reconsidered and withdrawn.

The rejection of claim 14 under 35 U.S.C. § 103(a), as being unpatentable over Ishikawa in view of Aoki '347, is respectfully traversed based on the following.

As noted above, Ishikawa does not show or suggest elements meeting the limitations of the image sensor, taking lens or optical element of claim 10. Similarly, Aoki does not show or suggest elements meeting these limitations. Claim 14 is dependent upon claim 10 and thus includes every limitation of claim 10. Therefore, claim 14 is not obvious over the cited references.

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Accordingly, it is respectfully requested that the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa in view of Aoki '347, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.


If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

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and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's
Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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